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EXPRESS MAIL NO. EU415106936US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#5  
8-9-02  
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Protest of U.S. Patent Application Serial No. 09/640,190

Examiner: Tam Tran

Art Group 2674

Protestor Ref. No.: 11257-3

Attention Director of Technology Center 2600  
Assistant Commissioner for Patents  
Washington, D.C. 20231

RECEIVED  
AUG 06 2002  
Technology Center 2600

PROTEST UNDER 37 C.F.R. § 1.291(a)

SIR:

In protest of the above-identified patent application, the following documents are submitted herewith:

- (1) a copy of U.S. Patent No. 6,380,926 (issued Apr. 30, 2002) ("926 patent" attached as Exhibit A);
- (2) a copy of U.S. Application Ser. No. 09/466,447 (filed Dec. 17, 1999) ("447 application", attached as Exhibit B);
- (3) a copy of U.S. Application Ser. No. 09/289,864 (filed Apr. 12, 1999) ("864 application", attached as Exhibit C);
- (4) a Certificate of Correction (attached as Exhibit D), which was filed with the Certificate of Correction Branch even date herewith. The correction requested is failure in the '926 patent to indicate that the '447 application is a Continuation of the '864 application. Correction is required to perfect priority of the '926 patent to the '864 application under 35 U.S.C. § 120.

Protestor learned of the above-identified application from a conversation with a distributor of computer mouse products that are believed to infringe the claims of the '926 patent. Protestor believes, based on such conversation, that the '926 patent, the '447 application, and the '864 application are material to the patentability of U.S. Patent Application Serial No. 09/640,190 ("Protested Application"). Protestor was unable to verify whether the enclosed have been cited to or by the Office in this case, and submits the enclosed to ensure that the Office is aware of the enclosed prior art references.

The '926 patent is a continuation in part of the '447 application and is therefore entitled to a priority date of at least Dec. 17, 1999. Thus, the '926 patent is available as prior art against the Protested Application under 35 U.S.C. § 102(e) and evidence of prior invention under 35 U.S.C. § 102(g).

Currently, the '926 patent does not reference the '864 application. However, as mentioned above, a Certificate of Correction has been filed even date herewith to correct this minor omission. Protestor expects the requested correction to be granted. Accordingly, upon correction, the '926 patent will be available against the Protested Application as prior art under 35 U.S.C. § 102(e) and evidence of prior invention under 35 U.S.C. § 102(g) as of April 12, 1999.

As you will see, the '447 application and the '864 application—which are essentially identical—disclose a sealed vessel, the vessel comprising two immiscible liquid layers of different densities, wherein one or more decorative objects float on the lower liquid layer. These applications further disclose that the decorative vessel can be a component of a computer mouse. See the '447 application, page 2, line 12 and FIGS 38A-38F; See the '864 application, page 2, line 12 and FIGS 38A-38F.

The '926 patent claims and discloses a computer mouse comprising a sealed decorative vessel having two immiscible liquid layers of different densities, wherein one or more decorative objects float on the lower liquid layer. See e.g., the '926 Patent Abstract.

Protestor respectfully requests that the Examiner consider these patents and patent applications in respect to the patentability of the Protested Application.

Pursuant to Manual of Patent Examiner Procedure § 1901.03 (8<sup>th</sup> ed. 2001), a protestor must serve duplicate copies of the Protest and references to the attorney of record, or, if the attorney of record is not known, a protestor must provide the U.S. Patent and Trademark Office ("PTO") with such duplicate copies for forwarding to the attorney of record. Protestor does not know the identity of the attorney of record. Accordingly, Protestor herewith submits duplicate copies of the Protest and Exhibits. **Protestor respectfully requests that the Examiner not forward a copy of the Certificate of Correction (Exhibit D) to the Attorney of Record unless the Examiner determines that such forwarding is necessary.** No charge is due for submission of this Protest.

Respectfully submitted